

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Joseph K. O'Sullivan et al. Art Unit : 2625
Patent No. : 7,619,784 Examiner : Houshang Safaipour
Issue Date : November 17, 2009 Conf. No. : 5339
Serial No. : 10/611,681
Filed : June 30, 2003
Title : PACING AND ERROR MONITORING OF MANUAL PAGE TURNING
OPERATOR

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 944 to 1,447 days is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed.

35 U.S.C. § 154(b)(2)(A). As outlined in *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. *Id.*

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. In *Wyeth*, the Court determined that this construction cannot be squared with the language of

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35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. *Id.*

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before August 30, 2004 (the date that is fourteen months after June 30, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on June 13, 2007, thereby according a PTO Delay of 1,017 days. Patentees do not dispute the PTO’s calculation for this “A Delay” from August 31, 2004 (the day after the date that is fourteen months after the date on which the application was filed), to June 13, 2007. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before October 19, 2008 (the date that is four months after June 19, 2008, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on January 7, 2009, thereby according a PTO Delay of 80 days. Patentees do not dispute the PTO’s calculation for this “A Delay” from October 20, 2008 (the day after the date that is four months after the date on which a response to Office Action was filed), to January 7, 2009. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 1,097 days (i.e., the sum of 1,017 days and 80 days).

“B Delay”

The period beginning on July 1, 2006 (the day after the date that is three years after June 30, 2003, the date on which the application was filed), and ending November 17, 2009 (the date the patent was issued), is 1,236 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1). In the present application, a Request for

Applicant : Joseph K. O'Sullivan et al.
Patent No. : 7,619,784
Issued : November 17, 2009
Serial No. : 10/611,681
Filed : June 30, 2003
Page : 3 of 5

Attorney's Docket No.: 16113-1305001

Continued Examination was filed on April 7, 2009, and the patent issued on November 17, 2009, resulting in a period of 225 days that must be excluded from the three year delay calculation.

In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4). In the present application, no Notice of Appeal was filed.

In view of the periods of “B Delay” detailed above, the total “B Delay” for this patent should be calculated as 1,011 days (i.e., 1,236 days minus 225 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentees respectfully submit that the PTO’s calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 1,011 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of “A Delay” and “B Delay”

As detailed above, “A Delay” accumulated during the following periods:

August 31, 2004, to June 13, 2007; and

October 20, 2008, to January 7, 2009.

As detailed above, “B Delay” accumulated during the following period:

July 1, 2006, to April 7, 2009.

As such, the periods of “A Delay” and “B Delay” overlap (i.e., occur on the same calendar day) for a total of 428 days, from July 1, 2006 to June 13, 2007, and from October 20, 2008 to January 7, 2009.

Applicant Delay

A reply to an Office Action was due on or before January 18, 2008 (the date that is three months after October 18, 2007, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on June 19, 2008, thereby according an Applicant Delay of 153 days. Patentees do not dispute the PTO’s calculation for this Applicant Delay from January 19, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to June 19, 2008. See 37 C.F.R. § 1.704(b).

Applicant : Joseph K. O'Sullivan et al.
Patent No. : 7,619,784
Issued : November 17, 2009
Serial No. : 10/611,681
Filed : June 30, 2003
Page : 4 of 5

Attorney's Docket No.: 16113-1305001

Patentees filed a Supplemental Reply on June 26, 2009, subsequent to a reply filed on April 7, 2009. No Applicant Delay was accorded for this reply; however, in good faith and candor, Patentees respectfully submit that the Supplemental Reply should have been accorded a total Applicant Delay of 80 days for delay from April 8, 2009, to June 26, 2009.

See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 233 days (i.e., the sum of 153 days and 80 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 944 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,680 days (i.e., the sum of 1,097 days of "A Delay" and 1011 days of "B Delay" minus 428 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 233 days (i.e., the sum of 153 days and 80 days); and
- 3) Total PTA should be calculated as 1,447 days.

Applicant : Joseph K. O'Sullivan et al.
Patent No. : 7,619,784
Issued : November 17, 2009
Serial No. : 10/611,681
Filed : June 30, 2003
Page : 5 of 5

Attorney's Docket No.: 16113-1305001

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 16113-1305001.

Respectfully submitted,

Date: January 14, 2010

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